

*Cited 13*

18. (Four Times Amended) An optical module comprising:  
a mounting member having a principal surface and a lateral surface, said  
mounting member entirely made of glass and having a core and a cladding formed therein,  
said cladding having its surface to form said principal surface in whole;  
an optical element mounted on said principal surface; and  
a semiconductor element driving said optical element, said semiconductor  
element mounted on said principal surface,  
wherein said mounting member has a function of an optical waveguide, and an  
optical input/output terminal for said optical waveguide is provided on said lateral surface.

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#### REMARKS

Claims 1-12 and 16-18 are pending. By this Amendment, claims 1, 4, 17 and 18 are amended. Reconsideration based on the above amendments and the following remarks is respectfully requested.

#### **I. The Claims Define Allowable Subject Matter**

The Office Action rejects claims 1-4 and 16-18 under 35 U.S.C. §102(b) as anticipated by "An innovative bonding technique for optical chips using solder bumps that eliminate chip positioning adjustments" by Hayashi; and claims 5-12 are rejected under 35 U.S.C. §103 as unpatentable over Hayashi in view of U.S. Patent No. 5,940,550 to Plickert et al. These rejections are respectfully traversed.

The applied art does not disclose a mounting member having cladding formed therein with the cladding having its surface to form the principal surface in whole, as claimed in claim 1 and similarly claimed in claims 4, 17 and 18.

Instead, Hayashi discloses an optical waveguide on a mounting member. The waveguide is provided in a groove formed in the mounting member. The waveguide forms only a portion of the principal surface. Thus, Hayashi fails to disclose a cladding having its

surface to form the principal surface in whole on which a semiconductor element is mounted.

Plickert does not make up for the deficiencies of Hayashi discussed above.

The claimed feature of the cladding and the principal surface, according to this invention, is best seen in Figures 1 and 2.

For at least these reasons, it is respectfully submitted that claims 1, 4, 17 and 18 are distinguishable over the applied art. The remaining claims, which depend from claims 1, 4, 17 and 18, are likewise distinguishable over the applied art for at least the reasons discussed as well as for the additional features they recite. Withdrawal of the rejections under 35 U.S.C. §102 and §103 is respectfully requested.

**II. Conclusion**

In view of the foregoing amendments and remarks, Applicants submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



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Attachment:  
Appendix

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